

Remarks and Arguments

1. Claims 1 – 3, 8, 10 – 12, and 17 have been rejected under 35 U.S.C. 102. The Office Action purports that the method and various embodiments thereof as claimed by the Applicant are anticipated by US Patent No. 5,828,514, to Chliwnyj et al. (hereinafter Chliwnyj '514).

The Examiner has dismissed on a wholesale basis the arguments set forth by Applicant in the Amendment of June 29, 2005. Applicant notes that the Examiner is "interpreting" the teachings of Chliwnyj '514 in order to support a rejection under 35 USC 102. Applicant notes that such interpretation is simply not allowed when attempting to establish anticipation. More over, "interpretation" is already strong evidence that the reference is some how different from the claimed method and apparatus.

A reference must specifically teach the claimed method and apparatus. If the claimed apparatus and method can be distinguished from the reference, a 35 USC 102 rejection is simply not proper. In order to anticipate a claimed invention, a *single unmodified reference must teach every element of the claimed invention*. The Applicant encourages the Examiner to appreciate current law such that "for a reference to anticipate the claimed invention, it must be indistinguishable from and be capable of performing the functions of the claimed invention". This test for anticipation have been followed as recently as In re Yanush, 477 F.2d 858, 959, 177 USPQ 705, 706 and In re Glass, 474 F.2d 1015, 1019, 176 USPQ 529, 532 (CCPA 1973).

As Applicant has already discussed, Chliwnyj '514 describes a technique whereby the position of a tape moving laterally across a tape head is controlled according to the position of the tape head relative to the frame of a tape drive (Col. 9; Lns. 26 – 27). This is clearly distinct from the method and

5 apparatus claimed by the applicant. Applicant claims a method and apparatus, as set forth clearly in Claims 1 and 10, wherein the position of the tape is controlled "according to ... sensed vibration" wherein the vibration is determined by sensing the vibration experienced by the tape transport mechanism.

10 Chliwnyj '514 does not teach sensing vibration of the tape transport mechanism. Hence, Chliwnyj '514 is incapable of sensing vibration of the tape transport mechanism. Again, the Examiner can not "interpret" (see Office Action of September 20, 2005 bottom of page 2 and top of page 3) sensing motion of the tape head relative to the tape driver as sensing vibration experienced by the tape transport mechanism. Because Chliwnyj '514 "is not capable of performing the functions of the claimed invention", the rejection of Claims 1 – 3, 8, 10 – 12, and 17 have been rejected under 15 U.S.C. 102 is improper and must be withdrawn.

20 Applicant again submits his earlier argument that detecting the relative position of the tape head with respect to the frame of the tape drive is a reactionary response to such relative movement. The claimed method and apparatus senses vibration of the tape transport mechanism, which often results in such relative movement. As such, the claimed method and apparatus anticipate such relative movements so that the position of a tape head relative to a moving tape can be controlled in anticipation to such relative movement. Hence, the claimed method and apparatus is able to 25 respond much more rapidly than the prior art of Chliwnyj '514. In fact, Chliwnyj '514 can not perform the anticipatory movement function that applicant has taught. Chliwnyj '514 can only respond to movements once they occur. Accordingly, not only is the claimed method and apparatus distinguishable from the teachings of Chliwnyj '514, the functionality taught by 30 the applicant is simply not even discussed by Chliwnyj '514.

With respect to the specific requirements to support a rejection under 35 USC 102, Chliwnyj '514 simply fails to disclose sensing of vibration. Because of this fact alone, Chliwnyj '514 can not be used to support a rejection under 35 USC 102. Applicant notes that the Examiner has "interpreted" Chliwnyj '514 to mean sensing of vibration. Applicant respectfully submits that such interpretation is not allowable in a 35 USC 102 rejection. The reference must specifically disclose the claimed method and apparatus. Applicant also notes that Chliwnyj '514 senses the position of the tape using an optical sensor, as described in the above referenced citation to Chliwnyj '514. This is further demonstrative of the fact that Chliwnyj '514 does not teach a vibration sensor.

2. Claims 19 – 21, 26, 28 – 30, and 35 had been rejected under 35 U.S.C. § 103(a), obviousness, over Chliwnyj '514 in view of Holmes et al. (a published application No. US 2003/0067703), hereinafter Holmes '703. In the currently operative office action, the Examiner indicates that the arguments made by Applicant with respect to the obviousness rejection purportedly supported by the combination of Chliwnyj '514 and Holmes are moot. Applicant kindly requests that Examiner properly address the rejection of Claims 19 – 21, 26, 28 – 30, and 35 under 35 U.S.C. § 103(a), obviousness, over Chliwnyj '514 in view of Holmes et al. Applicant does not consider his argument moot, but rather fully persuasive in that the Examiner has now identified a different reference for support of an obviousness rejection (see *infra*).

3. Claims 19 – 21, 26, 28 – 30, and 35 have been rejected under 35 U.S.C. § 103(a), obviousness, over Chliwnyj '514 in view of Smith (US Patent No. 6,633,448), hereinafter Smith '448. Applicant respectfully submits that the references cited by the Office Action fail to support a rejection under 35 U.S.C. § 103(a) and that the obviousness rejection must be withdrawn.

Applicant notes that the burden of establishing obviousness rests on the Examiner. In order to support a *prima facie* case for obviousness using a particular set of references, the references must exhibit the following attributes:

- (a) The prior art references must collectively teach or suggest all of the claim limitations in the application;
- (b) There must be a reasonable expectation of success in modifying the reference; and
- (c) The references must suggest or provide some motivation to modify and / or combine the reference teachings.

Here, the Examiner again insists that Chliwnyj '514 teaches a vibration sensor attached to a tape transport mechanism. Again, this is simply not true. The Examiner states that he interprets Chliwnyj '514 as teaching a vibration sensor. Smith '448, on the other hand, does teach the use of a vibration sensor, but this teaching is limited to the use of the vibration signal to enable engagement of a spindle locking mechanism described by Smith '448 (Col. 6, Lns 65 – 67). More importantly, Smith '448 teaches the use of a vibration sensor *on a disk drive*, not a tape transport mechanism as the Examiner avers. Applicant will not provide any specific reference to support this since the entire teachings of Smith '448, beginning with its title through the claims, is drawn only to controlling a spindle on a disk drive. Also, nowhere is there any discussion in either reference that suggests using a vibration control signal derived from sensing vibration of a tape transport mechanism as a basis for controlling position of a magnetic tape. Applicant calls the Examiner's attention to the fact that the rule stated above is absolutely clear and supported by a mountain of case law – the references must collectively teach each claim limitation.

A prima facie case of obviousness requires that there be found some motivation to modify and/or combine the reference teachings. This motivation can come from the references themselves. Here, no such motivation is found in either of the cited references. As an alternative to finding motivation in the references themselves, the Examiner must put forth a convincing line of reasoning as to why the artisan would have been motivated by the reference teachings to make the modification. The Office Action has not provided any rationale that would support this alternative motivation requirement. The Office Action only states that it would have been obvious to combine and/or modify the reference teachings and this alone is not enough.

There is not even a thin line of reasoning that would draw an artisan to look at Smith and incorporate a vibration sensor into a tape drive for the purpose of controlling tape position. What the Examiner has done is point to a reference from non-analogous art and state that "it would have been obvious".

Because it is the Examiner's burden to establish a prima facie case for obviousness, it is the Examiner that must demonstrate that the cited references support a rejection under § 103(a). At this juncture, Applicant is simply not motivated to further the analysis because, as Applicant herein avers, the cited references do not teach all of the limitations of the claimed invention. Since the cited references fail to support a rejection under 35 U.S.C. § 103(a) and because the Office Action has failed to establish a convincing line of reasoning as to why the references teachings should be combined and/or modified, the Office Action has procedurally failed to establish a prima facie case for obviousness. The Applicant respectfully submits that the obviousness rejection must be withdrawn.

As Applicant has already stated, Smith '448 is not drawn on analogous art with respect to the claimed method and apparatus. The claimed method and apparatus read upon controlling the position of a moving tape along a tape head. Smith '448 is drawn to controlling a spinning disk drive spindle. Accordingly, Smith '448 can not be used to support a rejection under 35 USC 103 and the rejection of Claims 19 – 21, 26, 28 – 30, and 35 must be withdrawn.

4. Applicant thanks the Examiner for finding allowable subject matter in Claims 4 – 7, 9, 13 – 16, 18, 22 – 25, 27, 31 – 34 and 36. The Examiner has suggested that these claims would be allowable if rewritten in an independent form. Applicant notes that these claims are dependant on Claims 1, 10, 19 and 28, which the Applicant has herein demonstrated to be distinguishable over prior art. As a result, Applicant respectfully requests that Claims 4 – 7, 9, 13 – 16, 18, 22 – 25, 27, 31 – 34 and 36 be further considered as allowable in their current form.

5. Based on the foregoing, Applicant considers the present method and all claimed embodiments thereof to be distinguished from the art of record. Accordingly, Applicant respectfully solicits the Examiner's withdrawal of the rejections raised in the above referenced Office Action, such that a Notice of Allowance is forwarded to Applicant, and the present application is therefore allowed to issue as a United States patent.

Respectfully submitted,

Jack I. J'maev
Attorney for Applicant
Reg. No. 45,669

Appl. No. 10/719,515
Amendment Date: December 20, 2005
Reply to Office Action of September 20, 2005

5 Intellectual Property Development
14175 Telephone Ave. Suite L
Chino, CA 91710

Phone 909-437-8390
email - <jack@develop-ip.com>

10